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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,089	11/03/2003	Erin Hall Sibley	PD-02-0421-B	9585
22462	7590	03/04/2009	EXAMINER	
GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			RABOVIAINSKI, JIVKA A	
ART UNIT		PAPER NUMBER		
2426				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/700,089	SIBLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JIVKA RABOVIANSKI	2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 December 2008.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 – 6 and 8 -16 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 – 6 and 8 -16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>01/12/2004</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

This office action is in response to applicant's response filed on December 16<sup>th</sup> 2008.

### ***Status of Claims***

Claim 8 has been amended.

Claims 1 – 6 and 8 -16 are pending in the Application.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 – 6, 8 – 11 and 13 -16 are rejected under 35**

**U.S.C. 102(e) as being anticipated by Krisbergh, Harold M. US  
20040078824 A1.**

**Regarding claim 1, Krisbergh teaches:**

A method for providing broadcast video programming, comprising:

(a) receiving video programming (Fig. 4 - the cable headend equipment; [0029]);

(b) encoding the video programming into a vertical blanking interval and unused Active lines of a television channel (the television transmission

may alternatively include one or more *streams of data comprising video, audio and other information in a digital and/or analog form*. Accordingly, information can be inserted into these streams such as in the VBI as aforesaid or as part of an MPEG transport stream [0027]; Fig. 4/46);

(c) broadcasting the television channel and encoded video programming into a vertical blanking interval and unused Active lines of a television signal (Fig. 4/12)

(d) receiving the broadcast encoded video programming in a vertical blanking interval in a user device, wherein the user device comprises (Fig.6/terminal 54):

(i) tuning hardware configured to receive normal over-the-air terrestrial broadcasts and to pass the encoded video programming in a vertical blanking interval (Fig. 6/94; television distribution systems and networks include but are not limited to orbiting satellite systems, terrestrial wireless cable systems [0024]);

(ii) vertical blanking interval software configured to:  
(1) receive output from the tuning hardware (Fig.6/94,92); and  
(2) decode the encoded video programming from the vertical blanking interval (Fig. 6/98);

(III) a screen and a speaker (Fig. 6/56; [0050]; and  
(iv) decompression software configured to:  
(1) decompress the decoded video programming (processor 96 for decoding and decompressing the coded and/or compressed refresh information [0049]); and  
(2) output analog audio and video signals from the decoded video programming to enable a user to watch the video programming on the screen and speaker of the user device (television signal is displayed on the display device – Fig. 6/56; the MPEG 2 data stream is composed of video, audio streams [0046]).

**Regarding claim 2, Krisbergh teaches:**

The method of claim 1, wherein the unused Active lines comprise Active lines that are hidden above and below typical lines that a viewer can see on a normal television screen. It is well known that the vertical blanking interval is the time interval between the end of the last line of one frame or field of a raster display, and the beginning of the next. During the VBI the incoming data stream is not displayed on the screen (unused Active lines). In analog television systems the vertical blanking interval can be used to

carry digital data, since nothing sent during the VBI is displayed on the screen.

**Regarding claim 3, Krisbergh teaches:**

The method of claim 1, wherein the encoded video programming is completely transparent to the television channel that is broadcast (The encoded broadcast video signal (Fig. 6) is applied to a video blanking interval decoder that decodes the encoded broadcast video and the encoded video signal can be watch on the TV screen).

**Regarding claim 5, Krisbergh teaches:**

The method of claim 1, further comprising receiving the broadcast encoded video programming in a wireless device (television distribution systems and networks include orbiting satellite systems, terrestrial wireless cable systems – [0024]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krisbergh, and further in view of Russ, Samuel H. et al (Russ hereinafter) US 20020059642 A1.**

**Regarding claim 6:**

The method of claim 5, wherein the wireless device comprises a receiver card for receiving the broadcast encoded video programming.

Krisbergh fails to teach a plug-in card for receiving encoded video program. However, Russ discloses PCMCIA card 163 (FIG. 1C) installed in the laptop [0083], [0052]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the teaching of receiver card as further taught in Russ to meet all limitation in claim 6, in order to help for user's mobility.

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krisbergh, and further in view of James, Randy (James hereinafter) US 20020019987 A1.**

**Regarding claim 8;**

The method of claim 7, wherein the vertical blanking interval software further comprises subscriber management, conditional access, and

encryption functions to control access to the video programming in the vertical blanking interval and unused Active lines.

Krisbergh discloses vertical blanking interval decoder, but fails to specify other functions. However, James discloses that the VBI receiver module is specifically designed for quick response VBI-ID/Message identification and subscriber communications processing – see include, but not limited to [0026].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the teaching of subscriber communication processing as further taught in James to meet all limitation in claim 8, in order to protect transmitted information from unattended access.

Regarding **claim 9** see the analysis of claim 1 above where the claim limitation was analyzed.

Regarding **claim 10** see the analysis of claim 2 above where the claim limitation was analyzed.

Regarding **claim 11** see the analysis of claim 3 above where the claim limitation was analyzed.

Regarding **claim 13** see the analysis of claim 5 above where the claim limitation was analyzed.

Regarding **claim 14** see the analysis of claim 6 above where the claim limitation was analyzed.

Regarding **claim 15** see the analysis of claim 7 above where the claim limitation was analyzed.

Regarding **claim 16** see the analysis of claim 9 above where the claim limitation was analyzed.

**Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisbergh, in view of Corvin, Johnny B. (Corvin hereinafter) US 20010029610 A1.**

**Regarding claim 4:**

Krisbergh fails to disclose the encoded video programming comprises a promotional cable channel. However, Corvin discloses that a program may be received on a program channel and a promotion may be received through this program channel's vertical blanking interval (VBI) – see [0024].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krisbergh with the

teaching of video programming comprises promotional channel as further taught in Corvin to meet all limitation in claim 4, in order to supply users with more information.

Regarding **claim 12** see the analysis of claim 4 above where the claim limitation was analyzed.

### ***Response to Arguments***

With respect to claims 1 and 9, Applicant argues that “Krisbergh cannot and does not provide such capabilities. Further, since Krisbergh requires a set top box that is separate from the display device ... speaker and screen are part of the device itself”, examiner respectfully disagrees. Krisbergh clearly teaches that “each downstream channel carries a television transmission which includes a plurality of sequentially transmitted picture fields, *audio*, and other related data streams” [0007]; “data streams containing required MPEG video, *audio* and control information” [0011]; “the television transmission 24 may alternatively include one or more streams of data comprising video, *audio* and other information in a digital and/or analog form” [0027]; “MPEG 2 data stream is composed of video, *audio* and other control information streams multiplexed into a bit stream” [0046]; “the display information is displayed on the display device 56 ... as

process of producing display information by a *set top terminal* 54" [0050], Figs. 5/70 and 5/56. The claim 9 cites: A user device comprising: a screen and speaker. A user device in the cited reference is the user terminal shown in Figs. 5/70 and 5/56 that is able to receive and reproduces data streams containing required MPEG video and audio. It is well known that in Digital television (DTV) is the sending and receiving of moving images and sound. Therefore the receiving terminal receives digital television signal including video and audio and reproduces both video and audio. All devices must have speaker for reproducing the audio part of the digital signal. For that reason, the limitation of claims 1 and 9 reciting: "A user device comprising: a screen and speaker" is thought by Krisbergh's reference. Applicant argues that "they both (James and Krisbergh) fail to also teach conditional access technology/controls within the same card", examiner respectfully disagrees. James discloses that "The receiver module is specifically designed for quick response VBI -ID/Message identification" in paragraph [0016], [0026] where message identification requires using conditional access such as passwords PIN and so on. Also, Krisbergh discloses that "a user of the access system 10 can type word commands" [0051] in order to communicate with the user terminal which includes

passwords and so on. Claims 8 cites: “the vertical blanking interval software further comprises subscriber management, conditional access ...” *VBI – ID* in James clearly teaches this limitation - identification in VBI see [0016], [0026]. Therefore, combination of these references teaches the limitations required by the claim. According to the Rational for Obviousness MPEP 2144 - “It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant”.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jivka Rabovianski whose telephone number is (571) 270-1845. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVEK SRIVASTAVA can be reached on (571) 272-7304. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jivka Rabovianski/

February 18, 2009

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2426